

Attorney's Docket No. 034183/233887

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 09/876,760 Confirmation No.: 2221
Applicants: Scheuber et al.
Filed: June 7, 2001
Art Unit: 2854
Examiner: J. E. Culler
Title: METHOD AND APPARATUS FOR PROVIDING TEXT ON PRINTED
PRODUCTS

Docket No.: 034183/233887
Customer No.: 00826

Mail Stop Appeal Brief-Patents
Commissioner for Patents
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REPLY BRIEF UNDER 37 CFR 1.193

This Reply Brief is filed in response to the Examiner's Answer mailed November 16, 2004.

Sections 1-6 of the Examiner's Answer are a verbatim recitation of the final rejection, and on pages 9-11, the Examiner has presented a section entitled Response to Arguments. It is submitted that the Examiner's responses to the arguments of the applicant are inadequate, for the reasons set forth below.

In the Appeal Brief, the applicant presented an argument that the subject matter of the Mowry patent is outside the field of technology to which the present invention relates and is unrelated to the problem solved by the present invention. In the Answer, the Examiner has contended that a broad definition of the field of technology as that of printing is appropriate because

"there is no language in the claims which narrows the definition beyond the application of printed text and information to a plurality of printed products. For example, appellant argues that one

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skilled in the former field of technology would not look to the latter field of technology to deal with the problems associated with applying labels to printed products which are being processed in an imbricated stream of high speeds. However, applicant's claims do not include these features."

The Examiner's contention is incorrect. Base Claim 5 specifically recites the step of conveying the printed products along a path of travel in an overlapping imbricated stream. The other base Claims 8 and 11 contain similar recitations. Thus the claims clearly limit the invention to a field which is much more narrow than the broad concept of printing a plurality of products.

In support of her position, the Examiner has referred to the case *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). This case is seen to clearly support the applicant's position regarding the impropriety of combining the disclosures of Mowry and Fröhlich. Specifically, in *Oetiker* decision, the CAFC reversed the Board's rejection based upon a combination of references, and the Court stated:

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

In the present case, it defies "common sense" to allege that one working in the field of printing address labels on

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products being conveyed in an imbricated stream would look to the individual printing of financial documents as disclosed by Mowry, for guidance on improvements.

The applicant also argued that Claims 8-10 further define the invention over Mowry and Frölich, by reciting that the partially transparent, contrast panel is printed onto the border region of each product of the imbricated stream, so as to overlie the printing on the printed surface of each product, and to allow the underlying printing to be seen through the contrast panel. In response, the Examiner stated that "these claims do not further distinguish the application (sic) from the references already discussed". It is submitted that the unique feature of the invention as set forth in these claims does indeed further distinguish the invention and the feature is not suggested by either Mowry or Frölich even when these references are considered collectively.

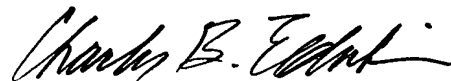
In response to the rejection based upon a proposed combination of A Century of Comics in view of Frölich, the applicant argued that four color printing does not allow for the underlying layer to be "seen through" later applied layers. In response, the Examiner has stated that such would be the case when using a "transparent" ink. The Examiner has not demonstrated that a transparent ink would ever be used in a four color printing operation, but rather, she has contended that the claims do not recite that the "text on a lower layer must be different in format or content from the additional layers". The claims at issue do in fact define very specifically the partially transparent contrast panel, note for example, the paragraph beginning at page 3, line 32 of the specification, which clearly would distinguish the contrast panel from the underlying layer or printing.

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The applicant further argued in the Appeal Brief that the rejection based upon a combination of A Century of Comics in view of Frölich, was untenable because four color printing of address labels on a moving imbricated stream of products would be technically difficult if not impossible. In response, the Examiner has merely stated that the four color printing "could be modified" to print an imbricated stream. How the process "could be modified" is not explained, and no such modification is apparent.

For the above reasons, and for the reasons set forth in the Appeal Brief, it is submitted that the rejection of the Claims 5-14 is legally untenable, and should be reversed.

Respectfully submitted,



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